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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/155,452	10/23/98	BORTS	R 263/PPIR1165

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HM12/0728

EXAMINER

ZAGHMOUT, O

ART UNIT

PAPER NUMBER

1649

DATE MAILED:

07/28/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/155,452

Applicant(s)  
Borts et al.

Examiner  
Ousama Zaghmout

Group Art Unit  
1649



☒ Responsive to communication(s) filed on Sep 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-10 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

**Election/Restriction**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, 10 are drawn to a process for the recombination in vivo of partially homologous DNA sequences having up to 30% of base mismatches wherein non-plant eukaryotic cells containing the sequences and in which an enzymatic mismatch repair system is defective, are maintained under conditions to effect meiosis, classified in class 800, subclass 278 for example.
  - II. Claims 1, 9 are drawn to a process for the recombination in vivo of partially homologous DNA sequences having up to 30% of base mismatches wherein plant cells containing the sequences and in which an enzymatic mismatch repair system is defective, are maintained under conditions to effect meiosis, classified in class 435, subclass 172.1 for example.
2. The inventions are distinct, each from the other because of the following reasons:
  - a. Each invention is drawn to molecularly, a biochemically and physiologically divergent products and processes not required by the other.
  - b. Group I is directed to a process of meiotic recombination in non-plant cells that entails the use of specific proteins such as mutS which are not required by the process of

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meiotic recombination in plants. Therefore, the inventions of group I and II constitute independent and distinct inventions within the meaning of 35 U.S.C. 121.

As such, the invention in each one of these groups require separate search and it be burden on the Examiner to examine more than one invention in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

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**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.  
July 23, 1999

  
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